Supreme Court, U.S.
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No. 94-1106

In The
Supreme Court of the United States
OCTOBER TERM, 1994

ROBERT W. KEARNS,
Petitioner,

v.

GENERAL MOTORS CORPORATION,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

D. DENNIS ALLEGRETTI
ALLEGRETTI & WITCOFF, LTD.
75 State Street
Boston, Massachusetts 02109
(617) 345-9100

Attorney for Respondent,
General Motors Corporation

BATEMAN & SLADE, INC. BOSTON, MASSACHUSETTS

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STATEMENT PURSUANT TO SUPREME COURT RULE 29.1

General Motors Corporation does not have a parent company. Its non-wholly owned subsidiaries that have issued shares to the public are identified below.

Publicly Traded Subsidiaries and Affiliates:

Isuzu Motors Ltd.
Suzuki Motor Corp.

Other Subsidiaries:

AC Bakony Kft.
Adela Investment Co. S.A.
AeroVironment, Inc.
AMBRAKE Corporation
Anadolu Otomotiv Sanayi VE Ticaret A.S.
Applied Intelligent Systems, Inc.
Aralmex, S.A. de C.V.
ARINC Incorporated
Asset Leasing GmbH
Aura S.r.l.
Autos y Maquinas del Ecuador S.A. (AYMESA)
Banque de Credit General Motors
Bujias Mexicanas, S.A. de C.V.
CAMI Automotive, Inc.
CEI Co., Ltd.
Calsonic Harrison Co., Ltd.
Carus Grundstucks-Vermietungsgesellschaft mbH & Co. Object Kuno 65 KG
Carus Grundstucks-Vermietungsgesellschaft mbH & Co. Object Leo 40 KG

Other Subsidiaries (Continued):

Centro Tècnico Herramental, S.A. de C.V.
Cilva Holdings Plc
Cimflex Teknowledge
Coalition Undertaking Remedial Efforts, Inc.
Colonial Mortgage Service Company of California
Comau Productivity Systems, Inc.
Compagnie des Faisceaux Tunisiens International S.A.
Compania Nacional de Direcciones Automotrices, S.A. de C.V.
Componentes Delfa, C.A.
Constructora Venezolana de Vehiculos, C.A.
Controladora General Motors, S.A. de C.V.
Convesco Vehicle Sales GmbH
DHB America Inc.
DHB-Componentes Automotivos S.A.
DRB s.a./n.v.
Daewoo Automotive Components, Ltd.
Delkor Battery Company, Ltd.
Detroit Diesel Corporation
Diavia S.r.l.
EDESA Societe Anonyme Holding
EPEC S.A.
Empresa Mixta GEMACVEN, S.A.
Freevale Limited
G. & F. Company
GM Nigeria Limited
G.M.A.C. Financiera de Columbia S.A. Compania de Financiamiento Comercial
General Motors Bankgesellschaft m.b.H.
General Motors Egypt, S.A.E.
General Motors France Automobiles S.A.
General Motors Hungary Automotive Distribution Limited Liability Company (aka General Motors Hungary (Distribution) Ltd.)

Other Subsidiaries (Continued):

General Motors Hungary Automotive Manufacturing Limited Liability Company (aka General Motors Hungary (Manufacturing) Ltd.)
General Motors Kenya Limited
Genie Mecanique Zairois, S.A.R.L.
I. K. Coach Co., Ltd.
IBC Vehicles (Distribution) Limited
IBC Vehicles Limited
ITC Inland Teknik Oto Yan Sanayi Limited Sirketi
Ilmor Engineering, Inc.
Ilmor Engineering, Ltd.
Industries Mecaniques Maghrebines, S.A.
Industrija Delova Automobila, Kikinda
Isuzu-General Motors Australia Limited
Isuzu Motors Limited
Jinbei GM Automotive Co. Ltd.
Kabeltrommel GmbH & Co. KG
Kabelwerke Reinshagen GmbH
Kabelwerke Reinshagen Werk Berlin GmbH (aka Kabelwerke Reinshagen Berlin Plant GmbH)
Kabelwerke Reinshagen Werk Neumarkt GmbH (aka Kabelwerke Reinshagen Neumarkt Plant GmbH)
Macopel, S.A. de C.V.
Mecel AB
Metal Casting Technology, Inc.
Millbrook Pension Management Ltd.
National Car Rental System Inc.
New Cure, Inc.
New United Motor Manufacturing, Inc.
New Venture Gear, Inc.
Omnibus BB Transportes, S.A.
Opel-Automobilwerk Eisenach-PKW GmbH (a/k/a Opel-AWE GmbH)

Other Subsidiaries (Continued):

Opel-Handler Versicherungsdienst GmbH
Opel-Wohnbau GmbH
P. T. Mesin Isuzu Indonesia
PDES, Inc.
PW-Allison Engines
Packard CTA Pty. Ltd.
Packard Electric Vas kft
Penske Transportation, Inc.
Perceptron, Inc.
Promotora de Partes Electricos Automotrices
Qual-Effic Services, Inc.
Robotic Vision Systems, Inc.
Ruedas de Aluminio, C.A.
Saab Automobile AB
Senalizacion y Accesorios del Automovil Yorka, S.L.
Shinsung Packard Company, Ltd.
Sociedad de Comercializacion Internacional Colmotores S.A.
Société Francaise des Amortisseurs de Carbon S.A.
Subaru-Isuzu Automotive, Inc.
Sung San Company, Ltd.
Suzuki Motor Corporation
Truck and Bus Engineering U.K., Limited
United Australian Automotive Industries Limited
Uveral S.A.
Vanguarda Componentes Automotivos, S.A.
Vauxhall Motors (Finance) Plc
View Engineering, Inc.
Volvo GM Canada Heavy Truck Corporation
Volvo GM Heavy Truck Corporation
Woodbridge Foam Deutschland, GMBH

Other Subsidiaries, and Affiliates of Electronic Data Systems Corporation:

Aristacom International, Inc.
BSS Belgique
BSS Greece
BehaviorTech, Inc.
Beijing International Information Processing Company Limited
CAPSCO Software Canada, Ltd.
CLIOR
CLS Corporation
COGSYS Limited
Centigram Communications Corporation
China Management Systems Corporation
Comtrac Corporation
EDS Hellas
EDS-Scicon Defence Limited
Emperion Corporation
Europe Assurance Informatique
F.I.J. (France Informatique Juridique)
Federal Integrated Systems Corporation
First City Bancorporation of Texas, Inc.
GEST'HELP Huissier
GMB Belgique
Healthco Holding Corporation
Hitachi Data Systems Holding Corporation
Hospitality Franchise Systems, Inc.
Infosys
Institut des Techniques Avancees
Interpractice Systems, Inc.
Japan Systems Kabushiki Kaisha (aka Japan Systems K.K.)
LEA GP Incorporated
MCE
Neodata Holdings, Inc.

Other Subsidiaries, and Affiliates of Electronic Data Systems Corporation (Continued):

Nippon EDS Co., Ltd. (aka Nippon EDS Kabushiki Kaisha)
Postal Buddy Corporation
PROGICAL
Riser Foods, Inc.
Simpad, Sociedad Anonima de Capital Variable (aka Simpad, S.A. de C.V.)
Soft-Switch, Inc.
Systems Control Technology, Inc.
Systems Technology Management Corporation
Telecommunications Data Services, Incorporated
The ASK Group, Inc.
Thomas Group, Inc.
Westcott Communications, Inc.
YLYS Informatique

Other Subsidiaries, and Affiliates of Hughes Aircraft Company:

ACCSCO S.A.
AMRAAM International Licensing Company
American Mobile Satellite Corporation
Comlinear Corporation
ELTRO GmbH
ELEKLUFT Elecktronik-und Luftfahrtgerate GmbH
Empresa Nacional de Optica S.A.
FLIR Systems, Inc.
First Portland Technology Corp.
Guiado y Control SA
HBH Company
HESI-FTIC Environmental Sciences, Inc.
Hughes Escorts Communications Limited

Other Subsidiaries, and Affiliates of Hughes Aircraft Company (Continued):

Hughes-JVC Technology Corporation
Hughes-Kenwood RDSS, Inc.
Hughes-Pareto Research Partnership
Hughes Software Systems Private Limited
i-Logix Inc.
Interactive Entertainment, Inc.
International Electro-Optical Industry Anonim Sirketi
International Mobile Machines Corporation
Japan Communications Satellite Company, Inc.
Japan Satellite Communications Network Corporation
Microelectronics and Computer Technology Corporation
Nippon Avionics Co., Ltd.
Pacific Monolithics, Inc.
RALS (RAM Alternate Launcher System)
Satelitron S.A. de C.V.
Societe Lyonnaise d'Informatique Boursiers
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Translant, Inc.
UKADGE Systems Limited

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No. 94-

In The

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OCTOBER TERM, 1994

ROBERT W. KEARNS,

Petitioner,

v.

GENERAL MOTORS CORPORATION,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

Respondent General Motors Corporation ("GM") hereby opposes the Petition for Writ of Certiorari filed by Robert W. Kearns ("Kearns") in this case.

STATEMENT OF THE CASE

Kearns' brief in support of his Petition reveals no more than a stubbornly disobedient litigant's attempt to lay blame on the entire "Judicial Branch" of government for the discretionary dismissal of a patent infringement action brought by him against

GM. Kearns' Petition, under the guise of a separation of powers "question", complains about the requirements of the "American Judicial System" and compliance with its rules of orderly procedure, while ignoring the obstinate conduct by him that forced the dismissal of his case. He does so *pro se* after having discharged successive able lawyers previously representing him, and at the final stage of his long litigation against GM which first began in 1985. He represents himself not out of need but by his own free choice, and in defiance of the repeated admonishments of the district court below to seek counsel.

Kearns was repeatedly warned, by the Michigan district court chosen by him for his action, that his willful refusal, while acting *pro se*, to comply with repeated pretrial orders essential to move the case to trial would result in dismissal. He was repeatedly warned to re-enlist counsel. At all relevant times, Kearns had the power as well as the duty to comply with the district court's orders and avoid the risk of such dismissal. It was ultimately Kearns' own stubborn disobedience that compelled a patience-worn federal judge to dismiss his case. (S.A. 12-25). Kearns sought reconsideration of the dismissal, which was denied. (S.A. 10-11). Upon his appeal, the United States Court of Appeals for the Federal Circuit affirmed, finding no abuse of discretion. (S.A. 1-9).[1]

Kearns is not a "Manufacturing-Inventor," as his Petition inappropriately asserts on its face.[2] Kearns merely procured patents directed to controls for use with automotive windshield wipers. Kearns, a litigation opportunist, has sued the entire

[1] Where, as here, the Court is offered an inadequate Appendix containing many typographical errors, it is permissible for the Respondent, under Sup. Ct. R. 15, to include with its Opposition a supplemental appendix containing material permitted by Sup. Ct. R. 14 for the convenience of the Court. GM identifies references to its Supplemental Appendix as "S.A."

[2] Kearns has provided no evidence of record in this case, nor is any discernible in any other case brought by him, to support his assertion that he is a manufacturing-inventor.

automotive industry[3] of the United States with respect to intermittent windshield wiper controls neither designed nor competitively manufactured by him. In pursuing his suit against GM, significant differences between the design of GM's controls and those of other car manufacturers named in his other actions jeopardized any prospect for past damages recovery under his five patents in suit. The expiration of all of those patents also precluded any coercive threat of injunctive relief.

Approaching trial after more than eight years of pendency of his action against GM, Kearns remained unable to identify any patent infringement basis for his original action against GM. He searched in vain for some other basis, but could find none. Despite exhaustive discovery disclosure of all GM controls made prior to expiration of his patents in suit, Kearns obstinately chose instead to refuse to obey the pretrial orders of the district court and define his suit. He thereby obstructed all reasonable, final preparations for an orderly trial.

The district court, after repeated orders and warnings to him, appropriately dismissed his action against GM in accordance with Rules 41(b) and 16(f), Fed. R. Civ. P. (S.A. 12-25). Upon appeal by Kearns, the United States Court of Appeals for the Federal Circuit affirmed, finding no abuse of discretion by the district court below. (S.A. 3-9).

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[3] *Kearns v. Wood Motors, Inc., Daimler-Benz Aktiengesellschaft, and Dr. Ing, h.c.f. Porsche A.G.* (78-CV-70642); *Kearns v. Fred Lavery Porsche, Volkswagen Werke A.G. Solfsburg, and Audi NSU Auto Union, A.G.* (82-CV-70749); *Kearns v. Ferrari S.p.A., AB-Volvo, Alfa Romeo S.p.A., Automobile-Citroen, S.A., Bayerische Motoren Werks, A.G., B-L, PLC (British Leland), Fuji Heavy Industries, Ltd., Group Lotus Cars Co., Honda Motor Co., Isuzu Motor Co., Ltd., Mitsubishi Motors Corp., Nissan Motor Co., Ltd., Officiene Alfiere Maserati, Peugot, S.A., Regie Nationale Renault, Rolls Royce Motors, Ltd., Saab-Scania AB, Toyo Kogyo Co., Ltd. (Mazda), Toyota Motor Co., Ltd.* (85-70459); and *Kearns v. United Technologies Corp. et al* (92-71408).

SUMMARY OF THE ARGUMENT

Kearns has failed to identify, either specifically or by reasonable inference, any question which would justify grant of his Petition and review of the decisions below. No conflicting appeals court rulings can be identified. No departure from accepted and usual judicial proceedings can be shown to have taken place. No unsettled federal law can be defined.

In his Petition, Kearns' questions presented do not dispute the correctness of the appeals court decision affirming the trial court's discretionary dismissal of his patent infringement action. Instead, Kearns improperly "seeks review" *de novo* of issues which have not been presented to or reviewed by the appeals court below.

Accordingly, Kearns' Petition for Writ of Certiorari should be denied by this Court as failing to raise any question which would justify grant of the Petition and review of the lower court decisions.

REASONS FOR DENYING THE PETITION

I. The Questions Presented By Kearns Were Never Presented To Or Reviewed By The Appeals Court Below.

Contrary to Kearns' suggestion, the courts below did not impede him. The nearly eight year pendency of the lower court action was largely attributable to Kearns' own dilatory conduct. During that period, Kearns was subjected to only three court ordered stays, totalling approximately eleven months, and each time for Kearns' own benefit primarily because he was engaged in proceedings with other alleged infringers.

Kearns never sought judicial review by the Federal Circuit below of any issue in this case relating to a claimed entitlement

to have his patents extended *beyond their statutory terms*, so as to retrieve the time of pendency of his infringement action against GM. Both GM and the public in general have been entitled at all times to fully rely upon the statutory expiration of his patents.

It is an abuse of the Petition procedure now to come before this Court, after affirmance on appeal, and seek *de novo* review of questions which were neither presented to nor reviewed by the appeals court below in this action.

II. KEARNS HAS FAILED TO IDENTIFY A QUESTION SUBJECT TO REVIEW UNDER SUPREME COURT RULE 10.

Neither of Kearns' questions presented, nor his Petition in general, meets the standard of Sup. Ct. R. 10. The Federal Circuit affirmed the district court's discretionary dismissal of Kearns' patent infringement lawsuit under Fed. R. Civ. P. 41(b), 16(f), and under its inherent administrative power, for repeated failure by Kearns to obey the court's orders designed to bring the action to trial. In seeking review, Kearns has cited no appeals court decision which conflicts with the Federal Circuit's affirmance, nor has Kearns demonstrated that the Federal Circuit's affirmance "so far departed from the accepted and usual course of judicial proceedings" as to require this Court's supervision. The Federal Circuit reviewed in detail, and specifically identified, the record evidence supporting the holding that the district court committed no abuse of discretion.

In affirming that dismissal, the Federal Court did not decide any question of federal law which is either unsettled or conflicts with applicable decisions of this Court. The Federal Circuit and the district court acted in full accord with *Link* v. *Wabash Railroad Co.*, 370 U.S. 626 (1962)(dismissal for failure to prosecute not an abuse of discretion where "it could reasonably

be inferred . . . from the drawn-out history of the litigation that petitioner had been deliberately proceeding in dilatory fashion.").

III. Both This Court And The Court Of Appeals For The Federal Circuit Have Expressly Declared All Remedies Under A Patent Grant To Be Terminated By Expiration Of The Seventeen Year Statutory Period.

The Constitution authorizes Congress to secure *for limited times* to inventors the exclusive right to their discoveries. Art. I, § 8, cl. 8. Congress exercises that authorization through the Patent Statute, which grants the patent owner the right to exclude others from making, using, or selling the patented invention in the United States for a period of seventeen years from the date of issuance of the patent. 35 U.S.C. § 154 (1988). These rights become public property upon termination of the patent's statutory term, and any further projection of the patent monopoly after expiration is not enforceable. *Brulotte et al.* v. *Thys Co.*, 379 U.S. 29, 30, 32 (1964). In fact, "any attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, whatever the legal device employed, runs counter to the policy and purpose of the patent laws." *Scott Paper Co.* v. *Marcalus Co.*, 326 U.S. 249, 256 (1945).

During that limited enforceable lifetime of a patent, the patent owner is authorized to bring a civil action as a remedy for infringement. 35 U.S.C. § 281 (1988). Money damages "adequate to compensate for the infringement" are authorized. 35 U.S.C. § 284 (1988).

In addition to money damages, 35 U.S.C. § 283 (1988) expressly provides for the grant of injunctions "in accordance with the principles of equity" since "[t]he nature of the patent

grant . . . weighs against holding that monetary damages will always suffice to make the patentee whole." *H.H. Robertson Co.* v. *United Steel Deck, Inc.*, 820 F.2d 384, 387-88, (Fed. Cir. 1987). Such equitable relief against *future* infringement, however, is necessarily discretionary with the trial court. 35 U.S.C. § 283 (1988). From the above discussion, it is quite clear that when the rights secured by a patent are no longer protectable by virtue of its expiration, entitlement to injunctive relief is correspondingly no longer available.

The questions which Kearns seeks to have reviewed by this Court are well settled in law and present no conflict either between appeals courts or with the law as set forth by this Court. Post-expiration injunctive relief is simply unavailable under the Patent Laws, and, if granted, would impermissibly extend the statutory term beyond that established by Congress. Congress has the power to provide for patent term extension in appropriate circumstances, *see* 35 U.S.C. § 155, 156 (1988), and it has chosen not to provide for post-expiration injunctive relief under the circumstances where a patent routinely expires during litigation. *See Denkler* v. *United States*, 782 F.2d 1003, 1008 (Fed. Cir. 1986) ("Should Congress wish to extend the [statute's scope], it knows how to do so.").

Accordingly, Kearns' questions presented, which have neither been presented to nor reviewed on any basis or in any forum on appeal below, should not and need not be reviewed *de novo* by this Court.

CONCLUSION

Kearns' Petition for Writ of Certiorari fails to identify any question which would justify grant of the Petition and review of the lower court decisions. Accordingly, Kearns' Petition for Writ of Certiorari should be denied.

Respectfully submitted,

D. DENNIS ALLEGRETTI
ALLEGRETTI & WITCOFF, LTD.
75 State Street
Boston, Massachusetts 02109
(617) 345-9100

Counsel for Respondent,
General Motors Corporation

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SUPPLEMENTAL APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

No. 93-1535

ROBERT W. KEARNS,
PLAINTIFF-APPELLANT,

v.

GENERAL MOTORS CORPORATION,
DEFENDANT-APPELLEE.

JUDGMENT

ON APPEAL from the United States District Court for the Eastern District of Michigan 85-70461

in CASE NO(S).

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED: AFFIRMED

ENTERED BY ORDER OF THE COURT

*DATED*_____ _____

Francis X. Gindhard, Clerk

BACKGROUND

On January 1, 1985, Dr. Kearns filed a complaint alleging that GM's intermittent windshield wiper circuits infringed five of his patents. Over the next seven years the case remained relatively dormant while Dr. Kearns engaged in litigation with other automotive companies. During this period, Kearns retained and dismissed his legal counsel twice, eventually deciding to proceed with the GM litigation *pro se*.

On July 31, 1992, the district court issued a pretrial order setting the trial date for October 21, 1992. This order also required Dr. Kearns to specify which claims he would assert and which GM circuits he would accuse of infringement. On April 20, 1993, the trial court instructed Dr. Kearns to limit the asserted claims to exceed no more than one representative claim per patent-in-suit and to limit the accused circuits to no more than five representative circuits. The trial court set June 21, 1993, as the deadline for Dr. Kearns to specify the claims and circuits.

On June 21, 1993, Dr. Kearns still had not identified the claims and circuits. Although Dr. Kearns had violated this deadline, the district court granted another five days to comply. At this time, the court warned Dr. Kearns that any further delays would result in a dismissal of the case. On June 22, 1993, in response to the trial courts simplification effort, GM agreed to let its five most common circuits represent 100% of its production, even though a total of 32 different circuits were produced during the period. On June 24, one day before the deadline, Dr. Kearns asked for another enlargement of time. In his letter requesting the extension, Dr. Kearns asserted all claims in all 23 of his patents against all 32 GM intermittent windshield wiper circuits, for a total combination of 7,424 claim chart interpretation. In response to this letter, the trial court's special master set July 2, 1993, as the final deadline

and reminded Dr. Kearns that there were only five patents in the complaint from which he could choose.

Dr. Kearns did not comply with the July 2, 1993, deadline. At the close of the business day on July 6, four days after the deadline, Dr. Kearns faxed the special master: "I update to all 32 GM circuits vs. every claim of every patent I hold." On July 9, 1993, GM filed a motion to dismiss on the basis of Kearns' failure to prosecute. On July 21, 1993, after a hearing on the motion, the district court dismissed the case with prejudice. Dr. Kearns subsequently appealed to this court.

DISCUSSION

A district court can use a variety of sanctions to ensure compliance with its orders, including dismissal of the lawsuit with prejudice. Fed. R. Civ. P. 16(f) and 37(b)(2)(C). According to the Supreme Court:

> [Dismissal with prejudice] must be available to the district court in appropriate cases, not merely to penalize those whose conduct may be deemed to warrant such a sanction, but to deter those who might be tempted to such conduct in the absence of such a deterrent.

National Hockey League v. *Metropolitan Hockey Club, Inc.*, 427 U.S. 639, 643 (1976). The Supreme Court further stated:

> The authority of a court to dismiss *sua sponte* for lack of prosecution has generally been considered an "inherent power", governed not by rule or statute but by the control necessarily vested in courts to manage their own affairs so as to achieve the orderly and expeditious disposition of cases.

Link v. *Wabash R.R.*, 370 U.S. 626, 630-31 (1962). Thus, a district court has ample power to dismiss for a party's refusal to obey orders. In reviewing the trial court's action, this court does not inquire whether "as an original matter [it] would have dismissed the action . . . [but] whether the District Court abused its discretion in so doing." *Id.* at 642.

In the absence of an essential relationship between its exclusive statutory mandate and a procedural issue, this court applies the Federal Rules of Civil Procedure according to the law of the regional circuit. *Biodex Corp.* v. *Loredan Biomedical, Inc.*, 946 F.2d 850, 857 (Fed. Cir. 1991). Therefore, this court applies the standard of the United States Court of Appeals for the Sixth Circuit for reviewing dismissals to remedy disobedience to court orders.

In the Sixth Circuit, a trial court may dismiss for disobedience when: (1) the party seeking dismissal suffers prejudice from the insubordination; (2) the disobedient party receives a warning that noncompliance may result in dismissal; and (3) the judge considers imposing less drastic sanctions before ordering dismissal. *Bank One of Cleveland, N.A.* v. *Abbe*, 916 F.2d 1067, 1073 (6th Cir. 1990). Moreover, Sixth Circuit precedent requires a finding of willfulness, bad faith, or fault on the part of the disobedient party before dismissal. *Regional Refuse Sys.* v. *Inland Reclamation Co.*, 842 F.2d 150, 153-54 (6th Cir. 1988). As noted above, the dismissal review must be for an abuse of discretion. *National Hockey*, 427 U.S. at 642. The Sixth Circuit defines abuse of discretion as "a definite and firm conviction that the trial court committed a clear error of judgment." *Logan* v. *Dayton Hudson Corp.*, 865 F.2d 789, 790 (6th Cir. 1989).

Without question, Dr. Kearns' refusal to obey the court orders prejudiced GM. GM could not reasonably prepare a defense to the infringement charges until it knew exactly which claims Dr. Kearns would assert. Throughout the proceedings

Dr. Kearns refused to accept that he could only assert patents listed in his complaint. Moreover, Dr. Kearns refused to comply with the district court's order to limit his case to one representative claim per patent. There are 51 claims in the five patents listed in the complaint and 232 total claims in all of Dr. Kearns' patents. In the facsimile from Dr. Kearns to the special master of 4:55 P.M., July 6, 1993, Dr. Kearns sought, despite clear orders to the contrary, to assert every claim of every patent he owned. Thus, he knowingly ignored the district court's reasonable order seeking to simplify a highly complex case.

The district court warned Dr. Kearns that continued refusal to comply with orders would result in dismissal of the case. At the conference on June 21, 1993, the trial court, referring to Dr. Kearns' repeated failure to limit his case as ordered, warned Dr. Kearns:

> And I caution you, if it's not done by [June 25, 1993], I will entertain a motion to dismiss the General Motors case for your failure to comply with the orders of the Court. The Court has been more than indulgent with you, Dr. Kearns, more than fair, given you more time than was reasonable.

Thus, Judge Cohn satisfied the Sixth Circuit's requirement that the party receive a warning.

The record also shows that the trial court weighed other options before dismissing the case. The transcript of the hearing on the dismissal date indicates that the district court considered allowing the special master to designate the limited number of claims. Finally, clearly exasperated at Dr. Kearns' failure to prosecute, Judge Cohn declared:

> I'm going to dismiss this case. My patience is at an end. My judicial patience is at an end. Dr. Kearns

> has had more than ample time in which to designate the claims. . . . Dr. Kearns is in complete default. A patent case cannot go forward without the claims-in-suit, the asserted claims being designated.

The complete transcript of that hearing shows that the trial court considered the alternative of designating the claims on its own, but decided that dismissal was more appropriate in light of Kearns' repeated refusals to obey pretrial orders.

After carefully examining the record, this court has no "definite and firm conviction that the trial court committed a clear error of judgment." *Logan*, 865 F.2d at 790. To the contrary, the district court judge made repeated efforts to accommodate the needs of this *pro se* litigant. As Judge Cohn pointed out in his August 9, 1993, order:

> There is a vast difference between a *pro se* plaintiff with a meritorious case unable to afford counsel and a *pro se* plaintiff with a meritorious case declining to employ counsel because of a misplaced lack of trust in lawyers or an inflated opinion notion of his ability to prosecute his own case. Here, we certainly have the latter. . . .

In a similar vein, the district court judge noted that:

> The civil justice system can absorb just so much abuse from a *pro se* litigant. Plaintiff clearly exceeded the limit of abuse and for that reason this case is no longer in court.

Dr. Kearns argues that the district court judge wrongly entertained the motion to dismiss under Rule 41(b). The unmistakable language of Rule 41(b) states that a court may dismiss a

case for noncompliance with "*any* order of court." Fed. R. Civ. P. 41(b) (emphasis added). Judge Cohn explained that the dismissal was justified because of:

> [t]he confusion exhibited by plaintiff's papers, his inability to focus his case, his complete failure to comply with the Court's order requiring that the claims-in-suit be designated . . . and offering no good reason for such failure.

The district court judge could also have used Rule 16, which permits dismissal under Rule 37(b)(2)(C) for failure of a party to comply with pretrial orders "upon motion *or the judge's own initiative*." Fed. R. Civ. P. 16(f) (emphasis added). Thus, dismissal was equally appropriate under either Rule 41(b) or Rule 16.

This court has considered Kearns' other arguments and find them without merit.

Because this court finds no abuse of discretion by the trial court, the decision of the district court is affirmed.

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Civil No. 85-70461

GENERAL MOTORS CORPORATION,

Defendant.

ORDER

On July 21, 1993 the Court entered an order dismissing this case for reasons stated on the record. On July 27, 1993 the Court filed a memorandum further explaining its reasons for the dismissal.

On August 4, 1993 plaintiff filed a motion styled PLAINTIFF KEARNS' MOTION FOR RECONSIDERATION OF THIS COURT'S ORDER OF 21 JULY 1993 OR, IN THE ALTERNATIVE, OFFER OF PROOF OF DESIGNATION OF BOTH CIRCUITS & CLAIMS together with a set of exhibits.

LR 7.1 provides

> (3) Grounds. Generally, and without restricting the discretion of the Court, motions for rehearing or reconsideration which merely present the same issues ruled upon by the Court, either expressly or by reasonable implication, shall not be granted. The movant shall not only demonstrate a palpable defect by which the Court and the parties have been misled

but also show that a different disposition of the case must result from a correction thereof.

Importantly, since plaintiff's papers do not deal with the reasons for dismissal: failure to designate a representative claim for each of the five patents alleged to be infringed, plaintiff has not demonstrated a palpable defect the correction of which would lead to a different disposition.

There is a vast difference between a *pro se* plaintiff with a meritorious case unable to afford counsel and a *pro se* plaintiff with a meritorious case declining to employ counsel because of a misplaced lack of trust in lawyers or an inflated opinion notion of his ability to prosecute his own case. Here, we certainly have the latter and the motion for reconsideration papers display the same sort of deficiencies which initially caused the Court to conclude dismissal was appropriate. See generally Rubin, *The Civil Pro Se Litigant* v. *The Legal System*, 20 Loyola U. Chi. L.J. 999 (1989).

SO ORDERED.

AVERN COHN
UNITED STATES DISTRICT JUDGE

DATED:

Detroit, Michigan

S.A. 12

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Civil No. 85-70461

GENERAL MOTORS CORPORATION,

Defendant.

MEMORANDUM

On July 21, 1993, the Court entered an Order which reads:

> For reasons stated on the record on July 21, 1993 because of plaintiff's failure to designate the claims-in-suit this case is DISMISSED.

Some further explanation beyond the reasons stated on the record is in order. The explanation follows.

This is a patent case involving allegations of infringement of intermittent windshield wiper patents owned by plaintiff. The complaint was filed January 31, 1985. Typical of a complaint in a patent case the allegations of infringement are conclusionary. Plaintiff alleges ownership of 5 patents as follows:

U.S. Patent No.	Title	Date of Issue
3,351,836	Windshield Wiper System with Intermittent Operation	November 17, 1967
3,581,178	Windshield Wiper Control Device	May 25, 1971
3,728,603	Windshield Wiper Control	April 17, 1973
3,796,936	Windshield Wiper Control Device	March 12, 1974
3,593,090	Intermittent Windshield Wiper System	July 13, 1971

No particular claim is alleged to have been infringed. As to infringement, the complaint simply alleges:

> GM has infringed, and is continuing to infringe, said patents in this District, and elsewhere, by making, using and selling and actively inducing others to make, use and sell intermittent windshield wiper systems and control devices embodying the inventions covered by claims of said patents.

Nothing significant occurred[4] in the case until July 23, 1992 when the Court held its first substantive status conference.

In the interim plaintiff successfully prosecuted patent infringement cases against Ford Motor Company and Chrysler Corporation in which he obtained substantial money judgments. The judgment in the Chrysler case is now on appeal. In the Ford case plaintiff was represented by counsel. In the Chrysler case the plaintiff was represented by counsel in the liability jury trial and appeared *pro se* in the damage jury trial. Plaintiff handled the post-trial matters in the Chrysler case *pro se*. In addition, plaintiff is currently prosecuting a patent case *pro se* against the major Japanese automobile manufacturers while cases against the European manufacturers are stayed.

Plaintiff is prosecuting this case *pro se*.

Following the status conference on July 23, 1992 the Court entered a pretrial order which reads in part:

> 4. The Court will hold a Rule 16 conference on August 13, 1992 at 2:00 P.M. to consider
>
> . . . . . .
>
> 6. A trial date (tentatively set by the Court as October 21, 1993).[5]
>
> . . . . . .

[4] On October 15, 1990, defendant, in an interrogatory, asked plaintiff to identify the claims infringed among other things. This request was renewed on May 17, 1993.

[5] Trial was subsequently scheduled to begin November 15, 1993.

d. Description of the claims-in-suit

e. Designation of the allegedly infringing circuits.

Following a pretrial conference on August 13, 1992 the Court entered a pretrial order which reads in part:

> It became apparent during the conference that there is uncertainty as to the grounds on which plaintiff claims infringement of his patents by defendant's circuits, particularly Delco #1, #2 and #3.

In the interim defendant disclosed to plaintiff each of the intermittent windshield wiper circuits it manufactured during relevant periods and the number of allegedly infringing units as to each such circuit.

On October 26, 1992, the Court entered an order regarding plaintiff's *pro se* representation which reads in part:

> To the extent that Kearns acts as his own counsel, he is subject to the same rules, regulations and sanctions which are applicable to attorneys appearing before the Court under the same circumstances.

The order also admonished plaintiff to obtain counsel rather than represent himself, as the Court had repeatedly done from the moment plaintiff advised the Court he intended to proceed *pro se*. In this connection the Court repeatedly observed on the record plaintiff's inadequacies regarding his *pro se* representation, particularly his woeful lack of understanding of procedure, and what was required of him as his own lawyer.

On December 18, 1992, the Court appointed a special master to report and recommend on defendant's motion for summary judgment. On March 23, 1993, the special master reported and recommended that defendant's motion be denied. The special master's report stated in part:

> The parties have submitted expert witness testimony which conflicts regarding claims interpretation and operation of the accused circuits.

In a footnote the special master recommended that since defendants' Delco circuits #1, #2 and #3 accounted for 73% of all of the allegedly infringing units they "would serve as an equitable representation of all GM circuitry at issue."

On April 21, 1993, the Court entered an order which reads in part:

> Dr. Kearns shall not be limited to the Delco 1 circuit in his pursuit of damages for infringement by GM. However, in the interest of an efficient and manageable trial, Dr. Kearns' cause of action will be restricted to representative claims and circuits designated by the Court at a later date, not to exceed one representative claims per patent-in-suit and not to exceed five representative GM circuits.

On May 6, 1993, the Court expanded the responsibilities of the special master to include all pretrial matters.

The Court, because of its concern over the progress of the case and plaintiff's *pro se* representation, held a status conference on June 21, 1993. June 21, 1993 was also the date by which plaintiff was required to designate the claims-in-suit.[6] At the conference the Court extended to June 25, 1993 the time for plaintiff to designate the claims-in-suit and cautioned plaintiff as follows:

---

[6] *See* footnote 1.

> And I caution you, if it's not done by [June 25, 1993] I will entertain a motion to dismiss the General motors case for your failure to comply with the orders of the court. The Court has been more than indulgent with you, Dr. Kearns, more than fair, given you more time than was reasonable. For you to stand there and suggest that you may accuse 32 circuits is beyond my comprehension. There is no jury in the world that could handle a case with 32 accused circuits.

Also, at the conference the Court asked defendant to agree that if plaintiff established infringement of the principle circuits identified as responsible for 92% of defendant's units this would establish infringement of 100% of the accused circuits. After a quick exchange of correspondence between June 22 and July 1, 1993 defendant agreed. Thus, by July 1, 1993 the accused circuits clearly were Delco #1, #2, #3 and #5 and Lectron 5.

On June 24, 1993, plaintiff asked for additional time by letter. The letter inexplicably listed 23 patents owned by plaintiff and the number of claims in each patent for an aggregate of 232 claims. See Exhibit A.

On July 2, 1993, the special master issued an order which reads in part as follows:

> Plaintiff Kearns was to formally designate the patent claims at issue and the GM circuits accused of infringing those claims by Monday, June 21, 1993, in response to GM's interrogatories.
>
> At a special Status Conference held that day in Detroit, Dr. Kearns indicated he had not complied and needed more time. Following this request by Dr. Kearns, the Court gave him until the close of

business Friday, June 25, 1993 to complete such designations. Dr. Kearns has now requested additional time in which to provide the above designation. Kearns based his request upon a lengthy medical examination which was to take place Friday, June 25, 1993. The Special Master understands the timing of such examination prohibited Dr. Kearns from working on such designations on that date. However, such designations were originally due the previous Monday, June 21. The Court extended the time to Friday *at Kearns' request*. Kearns, as is shown in this request of June 24, knew of his medical obligations at the time of the Status Conference and yet said nothing then.

More troubling is his continuing inability to properly prioritize his time: in his request for extension of time, he says that he "planned to write the referenced papers in that order". The "referenced papers" and their order are: (1) his Rule 60 (b) Motion in *Chrysler* regarding the Uruguay Round of the GATT Treaty, and (2) his circuits and claims designations. Kearns gave the "GATT motion" top priority, despite the Special Master's earlier denial of a similar motion in the GM case, and the Court's clear characterization of such GATT motions and issues as frivolous.

This case is set for trial November 15, 1993, some four months from now and substantial discovery remains to be completed. Dr. Kearns can no longer delay the designating of claims at issue and circuits allegedly infringing same. Moreover, Dr. Kearns' letter of June 24, 1993 refers to some 7,424 claim-circuit combinations potentially at issue, involving 23 different patents. There are only five patents in this suit from which to select claims. The five patents-in-

> suit are: 3,351,836; 3,581,178; 3,593,090; 3,728,603; and 3,796,936. With regard to the designation of circuits, the Special Master has previously identified five which represent 92% of GM's production and three circuits which represent 73%. This is the basis from which Dr. Kearns should be selecting.
>
> Accordingly, Dr. Kearns is to provide *complete* and *full* claim and circuit designations by 5:00 P.M. E.S.T. Friday, July 2, 1993, via facsimile with confirming copies by regular mail. *No further extensions of time will be granted.* (original emphasis)

On July 6, 1993, the plaintiff wrote to the special master seemingly indicating he had substantially completed the selection of the claims-in-suit and would confine his assertion of infringement to three circuits. However, he did not designate the claims-in-suit or give any indication as to which particular claims he was asserting were infringed.

On July 9, 1993, defendant filed a motion to dismiss on the grounds plaintiff had "failed to comply with this Court's orders to designate how defendant's circuits infringe which of plaintiff's patent claims thereby prejudicing defendant in the preparation of its case for trial" citing *Link* v. *Wabash Railroad Co.*, 370 U.S. 626, 630, 631 (1962) (dismissal for failure to prosecute not an abuse of discretion where "it could be reasonably inferred . . . from the drawn-out history of the litigation that petitioner had been deliberately proceeding in dilatory fashion"); *Carter* v. *City of Memphis, Tennessee*, 636 F.2d 159, 161 (6th Cir. 1980) ("[T]he key is a failure to prosecute, whether styled as a failure to appear at a pre-trial conference, failure to file a pre-trial statement, failure to prepare for conference, or failure to comply with the pre-trial order").

On July 13, 1993, the Court scheduled the motion for hearing on July 21, 1993. On July 13, 1993, plaintiff filed a non-

responsive letter styled "GM preliminary "designated" circuits and claims. . . ." See Exhibit B. The court immediately entered a Memorandum stating:

> Pending before the Court is a motion to dismiss for failure of plaintiff to designate the claims-in-suit as required by an Order of the Special Master dated July 2, 1993. A hearing before the Court is set on the motion for Wednesday July 21, 1993 at 3:30 P.M. On July 14, 1993 plaintiff lodged with the Special Master a paper which purports to designate the claims-in-suit as required by the Order. The paper is patently insufficient and not in conformance with the Order.

Plaintiff filed no further papers with the Court.

In the hearing on July 21, 1993, plaintiff continued to exhibit uncertainty as to which claims of which patents he intended to assert at trial were infringed and offered no good reason as to why he had not yet designated the claims-in-suit. Indeed, he suggested to the Court that he was not limited by the patents listed in the complaint and that perhaps infringement of 10 or more patents could be asserted.

On July 23, 1992, the Court initially set October 21, 1993 as the date of trial. Plaintiff having been through two jury tried patent infringement cases knows of the complexity of such cases and the extended effort necessary to prepare for trial. Plaintiff also knows that to enable a jury to adequately perform its duty it is necessary to limit the number of claims-in-suit and the number of accused circuits. Indeed, the Court had previously ordered such a limitation. As to accused circuits, on April 21, 1993, the special master recommended that the number of representative circuits be limited to 3.

Given the confusion exhibited by plaintiff's papers, his inability to focus his case, his complete failure to comply with

the Court's order requiring that the claims-in-suit be designated by July 2, 1993, and offering no good reason for such failure the Court's only course is to dismiss this case. Had plaintiff been represented by counsel, on the record made here, dismissal would have come at a substantially earlier date. The civil justice system can absorb just so much from a *pro se* litigant.[7] Plaintiff clearly exceeded the limit of abuse and for that reason this case is no longer in court.

AVERN COHN
UNITED STATES DISTRICT JUDGE

DATED:

Detroit, Michigan

[7] "The right of self-representation is not a license to abuse the dignity of the courtroom. Neither is it a license not to comply with relevant rules of procedural and substantive law." *Faretta* v. *California*, 422 U.S. 803, 835 fn. 46 (1975).

S.A. 21

24 June '93

Re: Rule 60(b) motion with regard to Uruguay Round "frivolous & denied" paper;

Designation of circuits.

Dear Judge Cohn,

I have a doctor's appointment at 10 A.M. this morning in Easton, Mary land. Tomorrow at 9:30 A.M. I have an all day appointment for a whole body physical with Johns Hopkins hospital in Baltimore starting with Dr. Shawn Simpson. I have waited months for this physical opportunity. The hospital telephoned me before the status conference to remind me, and I reconfirmed that I would be there during that call.

I planned to write the referenced papers in that order. You will see why when you read them.

May I have relief beyond 'close of business' tomorrow to designated the circuits of Mr. Allegretti?

Dr. Kearns' IWW U.S. Patent No.	Number of claims	Number of GM circuits	Number of claim charts to review
1. '836	19		
2. '331	23		
3. '459	17		
4. '159	6		
5. '227	17		
6. '374	18		
7. '584	9		
8. '178	9		
9. '747	18		
10. '090	18		

Dr. Kearns' IWW U.S. Patent No.	Number of claims	Number of GM circuits	Number of claim charts to review
11. '790	19		
12. '115	39		
13. '603	1		
14. '750	5		
15. '091	13		
16. '936	7		
17. '910	13		
18. '106	18		
19. '698	16		
20. '059	12		
21. '870 w/son, Tim	23		
22. '889	7		
23. '145	6		
	232 ×	32 −	7,424

cc: Mr. Allegretti
Do you oppose Judge Cohn granting me relief?

Cordially,
Robert W. Kearns
(410) 827-9337 (Tel/Fax)

EXHIBIT A

301 Houghton Lane
Queenstown, Mary land 21658
13 July 1993

William Brinks Olds Hofer Gilson & Lione
Attn: Master Vincent L. Barker, Jr.
1130 Edison Plaza
Toledo, Ohio 43604-1537

Sent by facsimile (419) 244-8862

Dear Master Barker:

Last week I went to Mr. Hall in Potomac, Maryland personally to discuss where we presently are in the cases. He is alerted and ready to work on the trial claims.

I have not been in contact with Dr. Meisel, but will do so promptly.

Judge Cohn asked about combining GM & Farrari in one validity trial. I answered, that if I could have two claims for the '836 patent, I thought he had a "winner" there. [See transcript of 21 June '93 pp. 33 - 36 Exhibits A & B]:

p. 33: THE COURT: Is there any commonality to the patents being asserted?

. . .

p. 36: DR. KEARNS: May I comment on that, your Honor?

THE COURT: Yes.

DR. KEARNS: In the case of the very first patent, the '836, your Honor, I have a patent in there which basically uses wound field motors. It's not the

magnetic field, but rather it's an inductance field. So, what I'm trying to say is, if the Court would allows me two claims in one patent then I think that your Honor's idea is a winner in that the rest of the patents —

THE COURT: Well, we'll see.
Okay.
Now, I have one more matter to deal with.

. . .

Exhibit C is a preliminary list of representative designated circuits and claims for 100% of GM's production of any IWW systems.

EXHIBIT B

It is preliminary in two regards:

1) it is subject to improvement by Mr. Hall & Dr. Meisel, my experts;

and,

2) it is subject to a reduction in number after the validity trial.

Dr. Kearns met his requirements for a Complaint against General Motors Corporation under Rule 11 and Rule 8 with knowledge of the Delco #1 circuit. [Exhibit D] He learned of the additional GM circuits through discovery. Dr. Kearns will seek leave of the Court to revise his Complaint to include the designated representative circuits and patents alleged infringed

to present correspondence with Exhibit C and the Complaint upon gaining said approval from his experts.

As Exhibit C stands, there are ten patents alleged infringed by Delco #1, #2 & #3 involving 11 claims. The '836 including claim 14, the wound field motor claim plus basic claim 16 found valid in *Kearns* v. *Ford*. These designated claims are listed in the column 'Trial Candidate'. Under the column 'Ferrari' are listed those patents and claims designated for that trial.

When the total claims for a combined validity trial are reckoned, there are 13.

Thus, for two more claims, a combined validity trial may be had. The total validity trial, moreover, has the advantage that four claims of the 13 claims were found valid in *Kearns* v. *Ford*. Dr. Kearns will move the Court for such a trial upon approval from said experts.

Hopefully, Exhibit C may serve as a preliminary work guide for the Special Master and the GM defendant until approved and/or modified by said experts.

Respectfully submitted,

Robert W. Kearns, Pro Se
(410) 827-9337

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Civil No. 85-70461

GENERAL MOTORS CORPORATION,

Defendant.

ORDER OF DISMISSAL

For reasons stated on the record on July 21, 1993 because of plaintiff's failure to designate the claims-in-suit, this case is DISMISSED.

SO ORDERED.

AVERN COHN
UNITED STATES DISTRICT COURT

DATED:
Detroit, Michigan